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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/063,736 | 05/08/2002 | Audrey Goddard | P3230R1C001-168 | 2794 |
| 30313 | 7590 | 10/12/2005 | EXAMINER | |
| KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET IRVINE, CA 92614 | | | SEHARASEYON, JEGATHEESAN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1647 | |

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 10/063,736 | Applicant(s) GODDARD ET AL. | |
| | Examiner Jegatheesan Seharaseyon, Ph.D | Art Unit 1647 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/22/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is in response to Applicants arguments and amendments filed 8/22/2005. The finality of the Office Action mailed 6/21/2005 is withdrawn. Applicants have cancelled 4-5, 14 and 16-31. Claims 6 and 11-13 are pending.

2. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.

3. The Office acknowledges the submission of the IDS dated 8/22/2005.

35 U.S.C. § 112, first paragraph, Enablement withdrawn

4. Applicants canceling of claims 4, 5, 14 and 16-31 have necessitated the withdrawal of rejection under 35 U.S.C. 112, first paragraph, as containing subject matter which was described in the specification in such a way as to enable one of skilled in the art to use the invention.

35 U.S.C. § 112, first paragraph, Written Description withdrawn

5. Applicants canceling of claims 4, 5, 7, 14 and 16-31 have necessitated the withdrawal of rejection under 35 U.S.C. 112, first paragraph, as containing subject matter which was described in the specification in such a way as to reasonably convey to one of skilled in the art that the inventors, at the time the application was filed, had possession of the invention.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(f) he did not himself invent the subject matter sought to be patented.

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6. The rejection of claims 4-6, 12-14 and 16-31 as being anticipated under 35 USC 102(e) by Lal et al. is withdrawn in favor of applying the art under 102(a). Applicant is correct in arguing that the art cannot be used under 102(e) based on the international filing date. However, as M.P.E.P 706.02(f)(1) states that " These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b)". Thus, the pending claims 6 and 11-13 are rejected as being anticipated under 35 USC 102(e) by Lal et al. (WO200000610 A2, Pub.1/2000).

7. Claims 6 and 11-13 are also rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Based on Applicants provisional application (60/170262) disclosure, it appears that the instant cDNA is derived from the Incyte LIFESEQ database EST clone No. 669971H1 (Appendix A, enclosed). Applicant states that "based on the DNA73897 consensus sequence and other information provided herein, a clone including another EST (Incyte DNA669971H1) derived from human cerebellum tissue was purchased and the cDNA insert was obtained and sequenced." Therefore, claims 6 and 11-13 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

8. No claims are allowable.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon, Ph.D whose telephone number is 571-272-0892. The examiner can normally be reached on M-F: 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/05


JANET L. ANDRES
SUPERVISORY PATENT EXAMINER

private (LIFESEQ®, Incyte Pharmaceuticals, Inc., Palo Alto, CA) databases. The signal sequence algorithm computes a secretion signal score based on the character of the DNA nucleotides surrounding the first and optionally the second methionine codon(s) (ATG) at the 5'-end of the sequence or sequence fragment under
5 consideration. The nucleotides following the first ATG must code for at least 35 unambiguous amino acids without any stop codons. If the first ATG has the required amino acids, the second is not examined. If neither meets the requirement, the candidate sequence is not scored. In order to determine whether the EST sequence contains an authentic signal sequence, the DNA and corresponding amino acid
10 sequences surrounding the ATG codon are scored using a set of seven sensors (evaluation parameters) known to be associated with secretion signals.

Use of the above described signal sequence algorithm allowed identification of an EST cluster sequence from the LIFESEQ® database, designated EST Cluster No. 135812 (Figure 3; SEQ ID NO:3). This EST cluster sequence was then compared to
15 a variety of expressed sequence tag (EST) databases (listed above) to identify existing homologies. The homology search was performed using the computer program BLAST or BLAST2 (Altshul et al., Methods in Enzymology 266:460-480 (1996)). Those comparisons resulting in a BLAST score of 70 (or in some cases 90) or greater that did not encode known proteins were clustered and assembled into a consensus
20 DNA sequence with the program "phrap" (Phil Green, University of Washington, Seattle, Washington; <http://bozeman.mbt.washington.edu/phrap.docs/phrap.html>). The consensus sequence obtained therefrom is shown in Figure 5 (SEQ ID NO:5), and is herein designated "DNA73897". In light of the sequence homology between the DNA73897 sequence and EST no. 669971H1 (Figure 4; SEQ ID NO:4), from the
25 LIFESEQ® database, EST clone 669971H1, derived from human cerebellum tissue, was purchased and the cDNA insert was obtained and sequenced. The sequence of this cDNA insert is shown in Figures 2A-2B and is herein designated as DNA81754.

The full length clone shown in Figures 2A-2B contained a single open reading frame with an apparent translational initiation site at nucleotide positions 10 to 12 and
30 ending at the stop codon found at nucleotide positions 343 to 345 (Figures 2A-2B; SEQ ID NO:2). The predicted polypeptide precursor (Figure 1, SEQ ID NO:1) is